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10/672,596	09/26/2003	Lynn Holm-Blagg	020375-040700	8648

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EXAMINER
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GRAHAM, CLEMENT B

ART UNIT	PAPER NUMBER
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3696

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11/26/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/672,596	<b>Applicant(s)</b> HOLM-BLAGG, LYNN	
	<b>Examiner</b> Clement B. Graham	<b>Art Unit</b> 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/28/07</u> .                                                | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. In view of the Appeal Brief filed on 05/27/08 PROSECUTION IS HEREBY REOPENED. New grounds of rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. Claims 1-27 remained pending.

### **Claim Rejections - 35 USC § 101**

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 11, 14, 21, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Applicant's claims are directed to an algorithm. Specifically, claims recites "receive", "incorporate" and "access" apply, however these steps are mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, for example) and abstract ideas without a practical application are found to be non-statutory subject matter. Therefore, Applicant's claims are non-statutory as they do not produce a useful, concrete and tangible result.

### **Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-27, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hilt et al(Herein Hilt U.S Patent 5, 465, 206) in of Blagg US Pub: 2004/0049452 A1 .

As per claim 1 Hilt discloses a system for implementing consumer based communication rules in relation to a financial account, the system comprising:

a microprocessor based rule engine (“i. e, “payment network rules” see column 18 lines 45-52) and a computer readable medium, wherein the computer readable medium includes instructions executable by the microprocessor based rule engine to:

receive a trigger, wherein the trigger indicates a correspondence associated with the financial account(Note Fig: 9 see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-62).

Hilt fail to explicitly teach receive a communication rule from a consumer participant associated with the financial account, incorporate the communication rule into a communication rule set maintained on the computer readable medium; access information associated with the financial account, apply the communication rule set to the information associated with the financial account, wherein a content of the correspondence is based at least in part on the application of the communication rule set.

However Blagg discloses a request from an entity maintaining the account to be associated identifies one or more of a presentation instrument 150, and an account holder to transaction processor. Where the request identifies the account holder is contacted to request permission to associate the new account with an existing presentation instrument held by the account holder. Alternatively, where the request does not identifies the account holder but rather identifies a presentation instrument, transaction processor matches the identified presentation instrument with the account holder and as previously discussed requests permission from the account holder to associate the new account with the presentation instrument. (see column 3-4 para 0034 and column 5 para 0043 and para 0046-0047 and column 7-8 para 0065).

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Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Hilt to include receive a communication rule from a consumer participant associated with the financial account, incorporate the communication rule into a communication rule set maintained on the computer readable medium; access information associated with the financial account, apply the communication rule set to the information associated with the financial account, wherein a content of the correspondence is based at least in part on the application of the communication rule set taught by Blagg in order to use financial products linked to a plurality of accounts to consummate financial transactions.

As per claim 2 Hilt discloses wherein the financial account is part of an account group, wherein the communication rule is directed to a set of financial accounts from the account group, wherein the set of financial accounts is selected from a group consisting of: all accounts within the account group, a subset of accounts within the account group, and a single account within the account group. (see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-62).

As per claim 3 Hilt discloses wherein the instructions are further executable by the microprocessor based rule engine to: provide an output directed to one or more members associated with the account group, wherein the output includes the correspondence. ( see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-53).

As per claim 4 Hilt discloses wherein the output is an electronic communication. ( see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-53).

As per claim 5 Hilt discloses wherein the output is selected from a group consisting of: a paper letter, an insert, a presentation instrument carrier, and a message placed on a statement. (Note Fig: 9 see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-67).

As per claim 6 Hilt discloses wherein the participant is a first participant, wherein at least a second participant is also associated with the financial account, wherein the communication rule is received from the first participant, and wherein the instructions are further executable by the microprocessor based rule engine to:

provide an output directed to the second participant, wherein includes the correspondence (Note Fig: 9 see column 18 lines 29-65 and column 21 lines 1-56 and column 10

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lines 1-62) provide a set of canned messages, wherein the communication rule indicates one of the set of canned messages; and

incorporate the canned message into the output. (Note Fig: 9 see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-50).

As per claim 7 Hilt discloses wherein the participant is a first participant, wherein at least a second participant is also associated with the financial account, wherein the communication rule is received from the first participant, wherein the communication rule includes a message provided by the first participant, and wherein the instructions are further executable by the microprocessor based rule engine to:

provide an output directed to the second participant, wherein the output includes the message provided by the first participant. ( see column 18 lines 29-65 and column 21 lines 1-56).

As per claim 8 Hilt discloses wherein the first participant is a Senior party in an account group, wherein the second participant is a junior party in the account group, and wherein the financial account is part of the account group. (see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-67).

As per claim 9 Hilt discloses wherein the communication rule indicates a communication preference. (Note Fig: 9 see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-50).

As per claim 10 Hilt discloses wherein the communication preference is selected from a group consisting of: a graphical presentation, a textual presentation, a summarized presentation, a multi-account presentation, and a message priority. (Note Fig: 9 see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-65).

As per claim 11 Hilt discloses a method for implementing consumer based communication rules in relation to a financial account, the method comprising:  
receiving an indication of a financial account, wherein the indication identifies a consumer participant associated with the financial account;  
providing a communication rules interface to the consumer participant over a communication network (Note Fig: 9 see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-62).

Hilt fail to explicitly teach receiving a communication rule via the communication rules

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interface receive a trigger, wherein the trigger indicates a correspondence associated with the financial account accessing information associated with the financial account; and applying the communication rule to the information associated with the financial account, wherein a content of the correspondence is based at least in part on the application of the communication rule.

However Blagg discloses a request from an entity maintaining the account to be associated identifies one or more of a presentation instrument 150, and an account holder to transaction processor. Where the request identifies the account holder is contacted to request permission to associate the new account with an existing presentation instrument held by the account holder. Alternatively, where the request does not identifies the account holder but rather identifies a presentation instrument, transaction processor matches the identified presentation instrument with the account holder and as previously discussed requests permission from the account holder to associate the new account with the presentation instrument. (see column 3-4 para 0034 and column 5 para 0043 and para 0046-0047 and column 7-8 para 0065).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Hilt to include receiving a communication rule via the communication rules interface receive a trigger, wherein the trigger indicates a correspondence associated with the financial account accessing information associated with the financial account; and applying the communication rule to the information associated with the financial account, wherein a content of the correspondence is based at least in part on the application of the communication rule taught by Blagg in order to use financial products linked to a plurality of accounts to consummate financial transactions.

As per claim 12 Hilt discloses wherein the participant is a first participant, wherein at least a second participant is also associated with the financial account, wherein the communication rule("i. e, "payment network rules" see column 18 lines 45-52) is received from the first participant, and wherein the method further comprises: providing an output directed to the second participant, wherein the output includes the correspondence, providing a set of canned messages, wherein the communication rule indicates one of the set of canned messages; and incorporating the canned message into the output. (Note Fig: 9 see column 18 lines 29-65 and column 21 lines 1-56).

As per claim 13 Hilt discloses wherein the communication rule includes a message provided by the participant, and wherein the method further comprises: providing an output directed to the participant, wherein the output includes the message provided by the participant. (Note Fig: 9 see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-60).

As per claim 14 Hilt discloses a method for implementing consumer based communication rules in relation to an account group, the method comprising: receiving an indication of an account group, wherein the indication identifies a member of the account group, and wherein the account group includes at least a first financial account and a second financial account providing a communication rules interface to the member over a communication network (see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-62).

Hilt fail to explicitly teach receiving a communication rule via the communication rules interface; accessing information associated with the account group and applying the communication rule to the information associated with the account group.

However Blagg discloses a request from an entity maintaining the account to be associated identifies one or more of a presentation instrument 150, and an account holder to transaction processor. Where the request identifies the account holder is contacted to request permission to associate the new account with an existing presentation instrument held by the account holder. Alternatively, where the request does not identifies the account holder but rather identifies a presentation instrument, transaction processor matches the identified presentation instrument with the account holder and as previously discussed requests permission from the account holder to associate the new account with the presentation instrument. (see column 3-4 para 0034 and column 5 para 0043 and para 0046-0047 and column 7-8 para 0065).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Hilt to include receiving a communication rule via the communication rules interface; accessing information associated with the account group and applying the communication rule to the information associated with the account group taught by Blagg in order to use financial products linked to a plurality of accounts to consummate financial transactions.



As per claim 15 Hilt discloses wherein the method further includes generating an output directed to one or more members associated with the account group, wherein the output is based at least in part on the application of the communication rule to the information associated with the first financial account and the information associated with the second financial account. (Note Fig: 9 see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-62).

As per claim 16 Hilt discloses wherein the output is selected from a group consisting of: an electronic communication, and a paper communication. (Note Fig: 9 see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-62).

As per claim 17 Hilt discloses wherein at least a first member and a second member are associated with the account group, wherein the communication rule is received from the first member, wherein the output is directed to the second member, and wherein the method further comprises:

providing a set of canned messages, wherein the communication rule indicates one of the set of canned messages; and

incorporating the one of the canned message into the output. (Note Fig: 9 see column 18 lines 29-65 and column 21 lines 1-56).

As per claim 18 Hilt discloses wherein the combination of the first member and the second member is selected from a group consisting of: a combination where the first member is a senior party and the second member is a junior party, a combination where the first member is a junior member and the second member is a senior member, and a combination where the first member and the second member are of equal status. (Note Fig: 9 see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-60).

As per claim 19 Hilt discloses wherein the first financial account is a liability account, and wherein the second financial account is an asset account. (Note Fig: 9 see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-62).

As per claim 20 Hilt discloses wherein the communication rule directs production of a comprehensive report about the account group. (Note Fig: 9 see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-52).

As per claim 21, Hilt discloses a method, comprising: receiving, by a financial institution at which a consumer maintains an account, an indication from the consumer that a communication,

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from the financial institution and regarding the account, is to include content selected by the consumer (Note Fig: 9 see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-52).

Hilt fail to explicitly teach receiving a communication rule via the communication rules interface; accessing information associated with the account group and applying the communication rule to the information associated with the account group.

However Blagg discloses a request from an entity maintaining the account to be associated identifies one or more of a presentation instrument 150, and an account holder to transaction processor. Where the request identifies the account holder is contacted to request permission to associate the new account with an existing presentation instrument held by the account holder. Alternatively, where the request does not identifies the account holder but rather identifies a presentation instrument, transaction processor matches the identified presentation instrument with the account holder and as previously discussed requests permission from the account holder to associate the new account with the presentation instrument. (see column 3-4 para 0034 and column 5 para 0043 and para 0046-0047 and column 7-8 para 0065).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Hilt to include receiving, from the consumer by the financial institution, an indication of what the consumer-selected content is to be, including the consumer-selected content in the communication and sending the communication taught by Blagg in order to use financial products linked to a plurality of accounts to consummate financial transactions.

As per claim 22, Hilt discloses wherein the indication of what the consumer-selected content is to be comprises a selection by the consumer of a message from a set of canned messages (Note Fig: 9 see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-52).

As per claim 23, Hilt discloses wherein the indication of what the consumer-selected content is to be comprises composition by the consumer of the consumer- selected content. (Note Fig: 9 see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-52).

As per claim 24 Hilt discloses wherein the consumer is one of at least two joint holders of the account, and wherein the consumer-selected content is directed from one joint holder to at

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least one other joint holder. (Note Fig: 9 see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-52).

As per claim 25 Hilt discloses wherein the consumer is a member of an account group, and wherein the communication is sent to at least one other member of the account group. (Note Fig: 9 see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-52).

As per claim 26 Hilt discloses wherein the communication rule directs the merging of multiple communications (Note Fig: 9 see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-52).

As per claim 27 Hilt discloses wherein the communication rule directs the merging of multiple communications (Note Fig: 9 see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-52).

## **Conclusion**

### **Response to Arguments**

6. Applicant's arguments filed 5/27/2008 has been fully considered but they are not persuasive for the following reasons.

7. In response to Applicant's argument that Hilt fail to teach or suggest" a microprocessor based rule and a computer readable medium, wherein the computer readable medium includes instructions executable by the microprocessor based rule engine to, receive a trigger, wherein the trigger indicates a correspondence associated with the financial account receive a communication rule from a consumer participant associated with the financial account, incorporate the communication rule into a communication rule set maintained on the computer readable medium, access information associated with the financial account, apply the communication rule set to the information associated with the financial account, wherein a content of the correspondence is based at least in part on the application of the communication rule set" the examiner disagrees with Applicant's because these limitations were addressed as stated.

Hilt discloses a system for implementing consumer based communication rules in relation to a financial account, the system comprising:

a microprocessor based rule engine ("i. e, "payment network rules" see column 18 lines 45-52) and a computer readable medium, wherein the computer readable medium includes instructions

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executable by the microprocessor based rule engine to:

receive a trigger, wherein the trigger indicates a correspondence associated with the financial account (Note Fig: 9 see column 18 lines 29-65 and column 21 lines 1-56 and column 10 lines 1-62).

Blagg discloses a request from an entity maintaining the account to be associated identifies one or more of a presentation instrument 150, and an account holder to transaction processor. Where the request identifies the account holder is contacted to request permission to associate the new account with an existing presentation instrument held by the account holder. Alternatively, where the request does not identifies the account holder but rather identifies a presentation instrument, transaction processor matches the identified presentation instrument with the account holder and as previously discussed requests permission from the account holder to associate the new account with the presentation instrument. (see column 3-4 para 0034 and column 5 para 0043 and para 0046-0047 and column 7-8 para 0065).

Therefore it is obviously clear that Applicant's claimed limitations were addressed within the teachings of Hilt and Blagg.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B. Graham whose telephone number is 571-272-6795. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CG

/Frantzy Poinvil/

Primary Examiner, Art Unit 3696

Nov 20, 2008